



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/786,567

02/25/2004

Masahiko Ando

83388.0017

2527

26021

7590

01/09/2006

HOGAN & HARTSON L.L.P.
500 S. GRAND AVENUE
SUITE 1900
LOS ANGELES, CA 90071-2611

EXAMINER

PRENTY, MARK V

ART UNIT

PAPER NUMBER

2822

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/786,567

Applicant(s)

ANDO ET AL.

Examiner

MARK PRENTY

Art Unit

2822

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 2-8 and 11-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date February 25, 2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

This Office Action is in response to the response filed on October 19, 2005.

Applicant's election without traverse of claims 1-8 and 11-13 is acknowledged.

Fig. 11(2) is objected to because its A-A' cross-sectional view is incorrect in showing four pieces of liquid-repellent film 4 (only two pieces should be shown, one in each of that view's two halves, as per Fig. 11(2)'s plan view). Correction is required.

Fig. 11(3) is objected to because its A-A' cross-sectional view's right-side half incorrectly shows electrode 5 between two pieces of liquid-repellent film 4 (electrode 5 should be on a middle portion of a single, continuous piece of liquid-repellent film 4, as per Fig. 11(3) of this application's foreign priority document). Correction is required.

Claims 11-13 are objected to because "the photosensitive liquid-repellent film" lacks antecedent basis in claims 1-5. Correction is required.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent Application Publication 2004/0129978 to Hirai.

As to independent claim 1, Hirai discloses (see the entire reference, including the Fig. 3 disclosure, for example) an electrode substrate comprising a substrate 1, a lower electrode 2, an insulating film 2a having a liquid-repellent region (under layer 6) and a liquid-attracting region (not under layer 6) on a surface thereof and an upper electrode 4/5, wherein the lower electrode, the insulating film and the upper electrode are layered in this order on the substrate; wherein a pattern shape of the lower electrode generally matches with that of the liquid-repellent region on the surface of the insulating film; and wherein the upper electrode is formed mainly on the liquid-attracting region excluding

Art Unit: 2822

the liquid-repellent region on the surface of the insulating film, such that the pattern shape of the upper electrode is a self-aligned shape in which the pattern shape of the lower electrode is generally reversed.

Claim 1 is thus rejected under 35 U.S.C. 102(e) as being anticipated by Hirai.

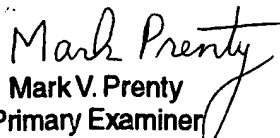
Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claims 2-8 are objected to as being dependent upon a rejected base claim, but would be allowable over the prior art of record if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record does not disclose or suggest the allowable devices taken as a whole, including the liquid-repellent and liquid-attracting regions.

United States Patent 6,828,582 is relevant to this application.

Registered practitioners can telephone the examiner at (571) 272-1843. Any voicemail message left for the examiner must include the name and registration number of the registered practitioner calling, and the Application/Control (Serial) Number. Technology Center 2800's general telephone number is (571) 272-2800.


Mark V. Prenty
Primary Examiner